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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,712	08/03/2001	Akihiro Miyata	07409.0024	5072

7590

09/18/2003

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 09/18/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,712

Applicant(s)

MIYATA ET AL.

Examiner

Jeffrey B. Robertson

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Huber et al. (U.S. Patent No. 4,474,933).

In reviewing applicant's response particularly with respect to the Feng et al. reference, the examiner's attention was drawn to the present reference. The examiner apologizes for not bringing this reference to applicant's attention in the previous office action.

For claims 1 and 4, in column 2, line 60 through column 3, line 15, Huber teaches that one mole of organofunctional silane is reacted with one mole of diisocyanate. This falls within applicant's reaction ratio of NCO/NH of from 3/1 to 3/2, because in each mole of diisocyanate, there are two isocyanate groups, where in each mole of silane, there is one NH group. Therefore, the ratio of NCO/NH is 2:1. For claims 4 and 7, here Huber teaches that hydroxyl polymers are added to the composition. In column 3, line 53, Huber expressly names n-phenyl-gamma-aminopropyltrimethoxysilane as an organofunctional silane. A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species is anticipated no matter how many other species are additionally

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named. Ex parte A, 17 USPQ 2d 1716 (Bd. Pat. App. & Inter. 1990) See also In re Sivaramakrishnan, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982). The silane contains a secondary amino group where the phenyl group is directly attached to the nitrogen. It is noted that in the examples for the formation of adduct, in column 5 line 51 through column 6, line 43, there are free isocyanate groups present after the reaction. For claims 2 and 7, in column 5, lines 56-58, Huber teaches isophorone diisocyanate, an alicyclic diisocyanate as an appropriate diisocyanate.

Response to Arguments

3. Upon reviewing the Rizk and Feng references, the examiner has decided to withdraw the rejection made under 35 U.S.C. §103. Specifically, since the Feng reference appears to also require that there be no free isocyanate groups present after treatment with the aminosilane, it is not known whether the mechanical improvements suggested in Feng would result if free NCO remained after the reaction with silane.

However, the examiner disagrees with some of applicant's remarks as set forth below. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., the storage stability of the silane) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, applicant argues that it would not be obvious to substitute the aminosilanes of Feng because the examiner has based this substitution solely on

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applicant's specification and that there is nothing in Feng to suggest an improvement in storage stability were the substitution made. In response, the examiner disagrees that this is based solely on applicant's specification. The examiner provided sufficient motivation in the improvement in elongation, flexibility and lower modulus of elasticity. Also, in response to applicant's argument that Feng describes nothing about the adhesion property of the silane compound, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

4. This rejection is non-final based on the application of new art, not necessitated by applicant's amendment.

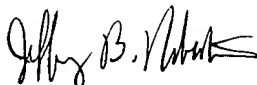
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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Jeffrey B. Robertson
Primary Examiner
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JBR